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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/628,481 | 07/29/2003 | Tomi Kimpimaki | 1497-120 | 4680 |

324 7590 09/27/2006

CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
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TARRYTOWN, NY 10591-9005

EXAMINER

NUTTER, NATHAN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1711

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|--------------------------------------|---|--|
| <p align="center">Advisory Action Before the Filing of an Appeal Brief</p> | Application No. 10/628,481 | Applicant(s) KIMPIMAKI ET AL. | |
| | Examiner Nathan M. Nutter | Art Unit 1711 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

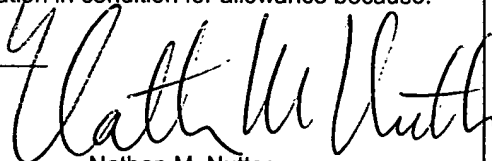
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: 17-19, 21-33, 35-44, 46 and 72-74.
 Claim(s) withdrawn from consideration: 47-49 and 51-71.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____



Nathan M. Nutter
Primary Examiner
Art Unit: 1711

Continuation of 5. Applicant's reply has overcome the following rejection(s): Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aho et al in view of Niinikoski et al.
Claims 17-19, 21-46, 72 and 73 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 50-62 of copending Application No. 10/508,349..

Continuation of 11. does NOT place the application in condition for allowance because: of the reasons set out in the Final Rejection. Further, thewith regard to Aho et al, applicants have manipulated their calcuylations to exclude talc as a solid in their interpretation of ratios. Talc, which is a solid at the temperatures at whicvh the invention is operable, would be included in the calcution, as put forth in the previous office action. The calculations are deemed to be correct and the reference shows the 90/10 ratio, as contemplated. Further, the method of the patent 6,545,079 and claimed herein are drawn to essentially the same concept but with different subsequent chracterization, ie one is a method of sizing but the other is a method of forming a transparent and gas-permeable coating. They are the same coating but with different characterizations thereof. If a term is written in a claim, indeed, the examiner may use the Specification to define that term .